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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,009	08/25/2003	Amlan Datta	129843.1104	3329
60148	7590	10/12/2007	EXAMINER	
GARDERE / JAMES HARDIE			MARCANTONI, PAUL D	
GARDERE WYNNE SEWELL, LLP			ART UNIT	PAPER NUMBER
1601 ELM STREET			1793	
SUITE 3000			MAIL DATE	
DALLAS, TX 75201			10/12/2007	
			DELIVERY MODE	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/648,009	DATTA ET AL.	

Examiner	Art Unit	
Paul Marcantoni	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 September 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 5-15 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 7-11 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,5,6 and 12-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

The applicants' 9/18/07 RCE and response has been considered but is unpersuasive.

New Matter:

Claims 1,5, 6, and 12-15 are rejected under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The numeral "59" with reference to amount of silicon oxide (should be correctly amended to silicon dioxide or silica) is new matter because there is only support for 58.9 wt% silicon dioxide from page 33 (synthetic microsphere A) of applicants' specification.

Provisional ODP

Claims 1,5, 6, and 12-15 remain provisionally rejected on the grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-27 and 1-15 of copending application nos. 2004/0081827 A1 (Datta et al.) and 2004/0079260 A1 (Datta et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a composition comprising microspheres that overlap the composition of one another. Overlapping ranges of amounts would have been *prima facie* obvious to one of ordinary skill in the art. Further, the applicants' new intended use of a known composition in their claims 12-15 is not a patentable distinction. The new use of a composition that is already known is not patentable.

35 USC 102/103:

Claims 1,5,6, and 12-15 are rejected under 35 USC 102(b) as anticipated by, or, in the alternative, under 35 USC 103(a) as obvious over Beck et al. (3M Patent-US Patent Number 3,365,315-also listed on page 11 paragraph [0038] of applicants' specification) or Goetz et al. (US Patent Number 4,983,550).

Response:

Should applicants amend their claim to 58.9 wt% silicon dioxide which is supported by applicants disclosure, the examiner will withdraw the new matter rejection.

Beck:

It is noted that Beck still meets applicants' claims because applicants' claim about 30 to 59 (wt)% silicon dioxide. The minimum silicon dioxide is 60 wt% silicon dioxide in Beck meets "about 59 wt% silicon dioxide" or even "about 58.9 wt% silicon dioxide". "About" permits some tolerance. At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%. In re Ayers, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). A pressure limitation of 2-15 PSI was held to be readable on a reference which taught a pressure "of the order of about 15 PSI." In re Erickson, 343 F 2d 778, 145 USPQ 207 (CCPA 1965). The examiner disagrees with applicants that Beck does not teach the final composition of his final microspheres. The examiner refers applicants to table I in column 4 (lines 25-40). That is represents what would be the final composition of the glass microspheres.

Goetz:

Applicants argue that Goetz does not teach less than 2 wt% potassium oxide.

The examiner disagrees. A look at the chart in claim 1 indicates that R₂O can be 2 to 15 weight percent of the hollow glass spheres. R₂O can be Na₂O alone in amounts meeting applicants claims of "about 4 to 10 wt%" in Goetz thus still meeting applicants' claims.

The examiner disagrees that Goetz does not teach less than 2 wt% potassium oxide.

Claim 2 of Goetz shows that R₂O can be Na₂O alone and thus not require the presence of any potassium oxide. Note that claim 2 has no requirement that there be a mixture or combination of sodium oxide and potassium oxide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul Marcantoni
Primary Examiner
Art Unit 1755